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09/890,910	08/02/2001	Takeshi Natsuno	9683/91	9817

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Brinks Hofer Gilson & Lione  
PO Box 10395  
Chicago, IL 60610

EXAMINER

LABAZE, EDWYN

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/890,910

Applicant(s)

NATSUNO, TAKESHI

Examiner

EDWYN LABAZE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. Claims 1-14 are presented for examination.

#### *Priority*

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
3. Receipt is acknowledged of the Request for Corrected Filing filed on 1/08/2002.
4. Receipt is acknowledged of the WO, 99/0952 dated 25/02/99; JP-3051748 dated 17/6/98; EP-820178-A2 dated 21/01/98; JP-8-153248-A dated 11/6/96; JP-6-121075A dated 28/04/94; JP-11-018158 dated 22/01/99; JP-8-279025 dated 22/10/96; JP-9-261359 which were cited in PCT international search report as a "X".

#### *Claim Objections*

5. Claims 2-13 are objected to because of the following informalities:

Re claim 2 (page 57, line 11): Substitute "A" with "The".

Re claim 3 (page 57, line 19): Substitute "A" with "The".

Re claim 4 (page 57, line 23): Substitute "A" with "The".

Re claim 5 (page 57, line 27): Substitute "A" with "The".

Re claim 6 (page 58, line 3): Substitute "A" with "The".

Re claim 7 (page 58, line 10): Substitute "A" with "The".

Regarding claim 7 (page 58, line 11), the phrase "type" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The applicant is required to remove or replace the word "type".

Re claim 8 (page 58, line 14): Substitute "A" with "The".

Re claim 9 (page 58, line 21): Substitute "A" with "The".

Re claim 10 (page 58, line 27): Substitute "A" with "The".

Re claim 11 (page 59, line 5): Substitute "A" with "The".

Re claim 12 (page 59, line 10): Substitute "A" with "The".

Re claim 13 (page 59, line 16): Substitute "A" with "The".

Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-5, 10, and 12-13 are rejected under 35 U.S.C. 102(e) as being <sup>anticipated</sup> ~~unpatented~~ by Mori et al. (U.S. 6,070,148).

Re claim 1: Mori et al. teaches an electronic commerce system and method for providing commercial information in e-commerce system, which includes a memory or storage unit 250 for

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storing card information items with regard to one or a plurality of cards (col.6, lines 23-25); and an output interface for reading out from the memory the card information items so as to be output (col.7, lines 17-45).

Re claim 2: Mori et al. discloses a system, which further comprises selecting means for selecting from the plurality of card information items a card information item desired by the user (col.13, lines 65+), wherein the output interface reads out from the memory or storage unit 250 the card information item selecting by the selecting means so as to be output (col.15, lines 1-67 and clo.16, lines 1-67).

Re claim 3: Mori et al. teaches a system, wherein the card information are information required for electronic-commerce transactions (col.2, lines 39-67; col.3, lines 1+; and col.7, lines 52-67).

Re claim 4: Mori et al. discloses a system, wherein the information required for electronic commerce transactions are credit card information (col.5, lines 7-15; col.11, lines 9-14).

Re claim 5: Mori et al. teaches a system, wherein the card information includes at least information for identifying the user (col.2, lines 54-59; col.17, lines 64-67).

Re claim 10: Mori et al. teaches a system, wherein the output interface comprises a code-displaying device for displaying code 240 that corresponds to card information read out from the memory or storage unit 250, the code being optically readable (col.6, lines 23-49).

Re claim 12: Mori et al. discloses a system, wherein the output interface comprises a data input/output terminal for performing data input/output with an external device 201 (col.7, lines 17+); and a data reading device for providing card information read out from the memory with the data input/output terminal 220 (col.6, lines 23+).

Re claim 13: Mori et al. teaches a system, wherein the mobile communication terminal is a mobile telephone 204 for performing wireless telephone communications (see Fig. #5 and col.7, lines 47-51).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6-7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (U.S. 6,070,148) in view of Miyake (U.S. 6,029,892).

Re claim 6: The teachings of Mori et al. have been disclosed above.

Mori et al. teaches a recording medium IC card 100 (col.5, line 10) and a reader/writer 210 (col.6, line 24), but fails to show that the output interface is a magnetic recording medium and a magnetic writer, and portable telephone 204 or 203 (see Fig.# 4 and col.7, lines 37-51).

Miyake teaches a method for electronically transferring personal information on credit card using portable terminal, which includes a magnetic recording medium or card 1 (col.7, lines 25-67) and a magnetic writer (col.12, lines 1-67; and col.13, lines 1-36).

In view of Miyake's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a magnetic recording medium/card and a magnetic writer into the teachings of Mori et al. Furthermore, the magnetic recording medium or card is a financial card with one or more magnetic stripes coated with a magnetizable medium to provide a generic magnetic track location capability, applicable in the electronic-commerce

transactions, enables the user to store encoded data and provide data exchange via a magnetically encodable medium and allow information to be read from and written to a magnetizable medium. Moreover, Mori et al. does not show transmitting means for performing wireless communication with other through a mobile network, but to one skilled in the art using portable telephone and Digital Assistant would require wireless communications such as RF or through a transceiver. In addition, such modification would have been an obvious extension as taught by Mori et al., therefore an expedient.

Re claim 7: Mori et al. discloses a system, wherein the magnetic recording medium is an IC card 100 that can be read by a card device (col.6, lines 1-49).

10. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (U.S. 6,070,148) as modified by Miyake (U.S. 6,029,892) and in view of Yazumi et al. (U.S. 6,321,980).

The teachings of Mori et al. as modified by Miyake have been discussed above.

Mori et al. as modified by Miyake fails to disclose an apparatus, wherein the magnetic recording medium/card being retracted inside the mobile communication terminal or protruded out by a predetermined operation on the mobile and delete the card information written in the magnetic recording medium.

Yazumi et al. teaches an electronic money storing apparatus and IC card control method, which includes a retracting system 205 (col.8, lines 33+) and deletes information when the IC card is removed (col.9, lines 30+).

In view of Yazumi et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate a predetermined operation also

known in the art as a shutter mechanism or a feeder into the teachings of Mori et al. as modified by Miyake to inserting and/or protruding the magnetic recording medium in the mobile terminal. Furthermore, such modification would have been an improvement of the teachings of Mori et al. as modified by Miyake and advantageous in preventing excessive force when inserting the card, and provide a better locking mechanism of the magnetic recording medium. In addition, such a system is well known in the art and widely used in the in personal computer for inserting the compact disk (CD) into the CD ROM drive and the magnetic writer automatically deletes all information written in the magnetic medium without enabling the saving mode when the push or key operation is activated to protrude the medium. Moreover, such modification would have been an obvious extension of the teachings of Mori et al. as modified by Miyake.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (U.S. 6,070,148) in view of Matsumoto et al. (U.S. 6,425,522).

The teachings of Mori et al. have been disclosed above.

Mori et al. fails to disclose an infrared interface for emitting infrared rays designating card information read out from the memory.

Matsumoto et al. teaches an IC card information processing system, which includes an infrared ray (col.10, lines 1+).

In view of Matsumoto et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize an infrared interface or transmitters for emitting infrared ray into the teaching of Mori et al. adapted for information transfer. Furthermore, the advantage of the infrared rays is the ability to read non-carbon inks and enable transmission/reception of data as infrared signal using infrared transmitters.



Moreover, such modification would have been an obvious extension as taught by Mori et al., therefore an expedient.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Forslund et al. (U.S. 6,250,557) discloses methods and arrangements for smart card wallet.

Gombrich et al. (U.S. 4,857,716) teaches patient identification system and method.

Makipaa et al. (U.S. 6,394,341) teaches a system and method for collecting financial transaction data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

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Edwyn Labaze

Patent Examiner

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December 26, 2002



KARL D. FRECH  
PRIMARY EXAMINER